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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/656,777

09/07/2000

Junji Kuyama

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02/23/2009

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EXAMINER

WILLS, MONIQUE M

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

02/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/656,777	<b>Applicant(s)</b> KUYAMA ET AL.	
	<b>Examiner</b> Monique M. Wills	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-48 is/are pending in the application.
- 4a) Of the above claim(s) 43-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

Claims 43-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected positive electrode, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 19, 2008..

***Response to Amendment***

This Office Action is responsive to the Amendment filed September 19, 2008.  
Claims 36-42 are rejected as follows:

**DETAILED ACTION**

***Response to Amendment***

This Office Action is responsive to the Amendment filed July 3, 2007. The  
Objection of claims 23 & 35 are overcome.

The claims are rejected as follows:

- Claims 23-25 under 35 U.S.C. 103(a) as being unpatentable over Isoyama et al., U.S. Patent 6,093,503.

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- Claims 26- 28 under 35 U.S.C. § 103(a) as being unpatentable over Isoyama et al., U.S. Patent 6,093,503 in view of Miyasaka U.S. Patent 5,869,208.
- Claim 35 is newly rejected under 35 U.S.C. 103(a) as being unpatentable over Isoyama et al., U.S. Patent 6,093,503.

A brief reiteration is recited below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-25 & 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isoyama et al., U.S. Patent 6,093,503.

With respect to claims 23 & 35, Isoyama teaches a method of making a positive electrode active material comprising: mixing a first ingredient of Ketjen Black and 90% by weight of lithium manganese oxide (Example 22); press molding the mixture (col. 12, lines 5-10); sintering the mixture in a temperature range from 300 to 1200°C embracing Applicant's range not lower than 600°C and not higher than 850°C (col. 7, lines 57-68); wherein the positive electrode is a lithium composite manganese oxide comprising an

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aggregate (col.2, lines 12-20) of primary particles having a grain diameter of 1 to 20 microns and the negative electrode is a metallic lithium (col. 2, lines 12-20). Further concerning claim 23, the lithium composite oxide is  $\text{LiMn}_2\text{O}_4$  meeting the general formula  $\text{Li}_x\text{Mn}_{2-y}\text{M}_y\text{O}_4$  where  $x=1$  and  $y=0$ . With respect to claims 24 & 25, the spinel  $\text{LiMn}_2\text{O}_4$  (col. 6, lines 25-30) has a primary particle size of 1 to 20 microns, embracing a primary particle diameter of 0.5 to 3 microns. Specific particle sizes of about 1 to 3 microns are exemplified in column 29, lines 24-50.

Isoyama does not expressly disclose: specific surface area measured by the BET method being between  $0.2 \text{ m}^2/\text{g}$  and  $2 \text{ m}^2/\text{g}$ ; the sequential steps of molding the mixture prior to sintering; and the negative electrode reversibly doping and dedoping lithium.

However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made mold the cathodic material prior to sintering, because selection of any order of performing process steps is prima facie obvious. In re Gibson, 39 F.2d 975, 5USPQ 230 (CCPA 1930).

The limitation in claim 23, with respect to the specific surface area measured by BET between  $0.2 \text{ m}^2/\text{g}$  and  $2 \text{ m}^2/\text{g}$ , is necessarily present in the cathode material set forth in the prior art, because Isoyama employs the same lithium manganese oxide material with the same primary particle size as set forth by Applicant. The limitation in claim 23, with respect to the negative electrode material reversibly doping and dedoping lithium is necessarily present in the negative electrode as set forth in the prior art, because Isoyama employs the same lithium anodic material set forth by Applicant. In accordance with MPEP 2144.04, "products of identical chemical composition can not

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have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 2d 1655, 1658.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isoyama et al., U.S. Patent 6,093,503 in view of Miyasaka U.S. Patent 5,869,208.

Isoyama teaches a method of making a positive active material as described in the 35 U.S.C. § 103 rejection hereinabove. The method includes creating a slurry by kneading an admixture of graphite and polyvinylidene fluoride (col. 5, lines 35 & col. 39, lines 10-20) with  $\text{LiMnO}_2$  dissolved in a liquid phase (col. 39, lines 5-20). The lithium oxide, conductive agent and binder are mixed in a weight ratio of 9: 0.6 to 0.4 (col. 39, lines 10-20). With respect to claim 28, cathode material is applied to an aluminum foil current collector (col. 39, lines 10-15) with a thickness of 0.02 to 200 microns.

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Isoyama is silent to creating a slurry of active material, binder and conductive agent, employing 86% lithium composite manganese oxide (claim 276) and 10% graphite. The reference is also silent to pulverizing the sintered mixture. Isoyama does not expressly disclose controlling the specific surface area of the aggregate or aggregate particles.

Miyasaka teaches that it is conventional to create a slurry of electrode material prior to coating on a current collector (col. 123, lines 5-15). The electrode material includes lithium manganese oxide, a binder and conductive agent (col. 12, lines 5-15). The reference also teaches pulverizing to increase the specific surface area of the active material (col. 11, lines 20-30).

It would have been obvious to one having ordinary skill in the art at the time the instant invention was made to employ the slurry preparation of Miyasaka in the method of Isoyama, in order to facilitate coating electrode material on the current collector. The skilled artisan recognizes that a slurry would increase malleability of the active material thereby improving coating ability of said material on the current collector.

With respect to pulverizing the sintered electrode material, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made, because even though Isoyama is silent to pulverizing the active material, Miyasaka teaches that pulverization increases the specific surface area of the active material (col. 11, lines 20-30).

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With respect to the amount of lithium manganese oxide, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ 86% by weight lithium manganese oxide since it has been held that discovering optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 2727, 205 USPQ 215 (CCPA 1980). The skilled artisan recognizes that the amount of active material directly effects the amount of voltage and current produced by the cell.

With respect to the amount of graphite, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ 10% by weight of graphite since it has been held that discovering optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). The skilled artisan recognizes that the amount of conductive agent directly effects conductivity of the electrode.

With respect to controlling the specific surface area of the aggregate or employing aggregate particles, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ the instant particle characteristics to increase utilization of the electrode. The skilled artisan recognizes that manipulating surface area increases cathode utilization.

### ***Response to Arguments***

Arguments are moot, as the rejection has been reapplied on new grounds.

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Applicant asserts that Isoyama is not obvious over the instant claims because the reference teaches using a different sequence of steps and thus, arrives at a different result. Specifically, Isoyama teaches mixing the previously sintered cathodic material before press molding. In contrast, Applicant's claimed invention molds a mixture of a lithium composite oxide and then sinters. This argument is not persuasive. In accordance with MPEP 2144.04, selection of any order of performing process steps is prima facie obvious. See *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959). Therefore, it would be obvious to reverse the molding/sintering order in preparation of a positive electrode material. In order to overcome this rejection, it is suggested that a declaration is filed that compares the closest prior art. Specifically, a declaration proving that Isoyama does not produce a cathode with a specific surface area within the desired range is required. The declaration filed April 12, 2004, asserts unexpected results, but fails to illustrate that prior art produces specific surface areas outside the instant range. The declaration filed September 28, 2006, asserts unexpected results, but fails to compare Isoyama with the instant invention. The declaration recites comparative examples set forth in the specification and compares them to the instant invention, but does not do so with the references of record. Therefore, the rejections are maintained.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (571) 272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Patrick Ryan, may be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.


Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Monique M Wills/

Examiner, Art Unit 1795

/PATRICK RYAN/

Supervisory Patent Examiner, Art Unit 1795

<div>Application Number</div> <div></div>	Application/Control No.	Applicant(s)/Patent under Reexamination	
	09/656,777	KUYAMA ET AL.	
	Examiner	Art Unit	
	Monique M. Wills	1795	